

**REMARKS**

Reconsideration and allowance of the claims are requested in view of the above amendments and the following remarks. Claims 1-2, 15, 17, 32-33, 37-38, 51-52, 54, 69, 73, 77, 82, 85, 87 and 89 have been amended. Support for the amendments to the claims may be found throughout the specification and the claims as originally filed. No new matter has been added. Claims 5-6, 11-14, 16, 41-42, 47-50, 53, 78 and 91-97 have been canceled without prejudice or disclaimer.

Upon entry of the amendment, claims 1-4, 7-10, 15, 17-40, 43-46, 51-52, 54-77 and 79-90 will be pending in the present application with claims 1, 2, 15, 32-33, 37-38, 51-52, 69, 73, 77, 82, 85, 87 and 89 being independent.

**1. MPEP § 2114**

The Office Action asserts that claims 1-15, 17-52 and 54-90 contain clauses which are essentially method limitations or statements of intended use which do not serve to patentably distinguish the claimed structure over the cited reference. Applicant respectfully disagrees.

First, Applicant respectfully submits that MPEP §2114 is inapplicable to claims 37-40, 43-46, 51-52, 54-72. Each of these claims recites either a “method of monitoring a set of operational characteristics of a vehicle” or a “method of monitoring a set of vehicles.” Accordingly, these claims are method claims. Applicant respectfully submits that MPEP §2114

does not apply to these claims. Therefore, for at least this reason, MPEP §2114 has no bearing on the interpretation of claims 37-40, 43-46, 51-52, 54-72.

Second, Applicant respectfully submits that the referenced clauses in claims 1-4, 7-10, 15, 17-36 and 73-90 are structural limitations, not method limitations or statements of intended use. When a general purpose computer is programmed, or configured, to carry out the claimed invention, “such programming creates a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software.” *In re Allapat*, 33 F3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994).

The Office Action asserts that clauses such as “monitorable operational characteristics” are essentially method limitations or statements of intended use. (Office Action, page 33, paragraph 5). However, each limitation containing one of the referenced clauses recites a component “configured to” carry out an aspect of the claimed invention. For example, claim 33, as amended, recites the following language, among other elements:

wherein the host computer is further configured to wirelessly receive collected vehicle data of the target vehicle, the collected data including the subset of monitorable operational characteristics identified in the transmitted software component.

Claim 33 does not recite a method for monitoring operational characteristics. Rather, it recites a “host computer . . . configured to wirelessly receive collected vehicle data” followed by the referenced clause which describes the collected data that the host computer is configured to

wirelessly receive. This limitation is structural because it does not recite a step to be taken. Instead, this limitation recites a computer which is configured to perform particular functions. Therefore, for at least this reason, the referenced clauses in claims 1-4, 7-10, 15, 17-36 and 73-90 recite structural limitations that patentably distinguish the claimed invention from Spaur.

Third, Applicant respectfully submits that Spaur cannot anticipate the present invention because there are structural differences. MPEP §2114 states that “even if the prior art device performs all of the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference.” The Office Action asserts that Spaur teaches that the user specifies a rate for automatically querying a vehicle’s on-board computer by physically inserting a PCMCIA card. However, claim 1 recites a “wireless communication component configured to wirelessly receive a software component configured to identify a subset of the set of operational characteristics that are monitored by the on-board diagnostic computer, a user specified first schedule, and a user specified second schedule. And does not teach the elements of wirelessly receiving a user specified first schedule and a user specified second schedule. Therefore, Applicant respectfully submits that, for at least this reason, Spaur cannot anticipate claims 1-4, 7-10, 15, 17-36 and 73-90 because there is a structural difference.

## **2. Rejections Under 35 U.S.C. §112**

The Office Action rejects claims 32 and 51 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claims the subject matter which

Applicant regards as the invention. Applicant respectfully traverses this rejection.

Applicant respectfully disagrees with the assertions in the Office Action that the term “schema” is indefinite as applied to the claim language. Applicant can be his own lexicographer (see MPEP 2173.01). The term “schema” is defined in the specification, for example, at least at page 4, lines 17-22 and page 12, lines 12-14. However, for purposes of expediting prosecution, claims 32 and 51 have been amended to replace the term “schema” with “software component” in order to overcome the rejections under 35 U.S.C. §112, second paragraph.

For at least this reason, reconsideration and withdrawal of the rejection of claims 32 and 51 under 35 U.S.C. §112, second paragraph, are respectfully requested.

Applicant notes that claims 17 and 54 also contain the term “schema.” Claims 17 and 54 have also been amended to replace the term “schema” with “software component.”

### **3. Rejections Under 35 U.S.C. §102(b)**

The Office Action rejects claims 1-4, 6-15, 17-40, 42-52, 54-77 and 79-90 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,732,074 to Spaur et al. (“Spaur”). Applicant respectfully traverses this rejection.

The Office Action fails to show that the claims are anticipated. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicant respectfully submits that

Spaur does not anticipate claim 1 for at least the reason that Spaur does not disclose, teach or suggest a “wireless communication component configured to wirelessly receive a software component,” as recited in claim 1.

Spaur discloses a mobile portable wireless communication system computer terminal at a remote site that can communicate with a first standard communications network link, such as the Internet, through a modem. The computer terminal supplies a browser with an IP address that is associated with a particular vehicle, including communications related hardware contained in the vehicle (see col. 2, lines 25-34; Figures 1 and 2). The system allows for bi-directional communication between one or more remote stations 10a-10n and a vehicle, which includes a wireless device 18 that is able to transmit and receive information via an airlink to the remote stations (see col. 5, lines 41-43; col. 6, lines 3-14).

Spaur teaches that data memory 106 may store page information that is accessible by a web server 102. Web server 102 services requests which “include obtaining or getting information, as requested, and the sending or posting of information, as requested.” (see col. 8, lines 40-44). The requests are generated when “the user inputs a message at the computer terminal 60, in accordance with block 200.” (see block 200, Fig.3; col. 12, lines 43-44). Therefore, Spaur teaches that the transmission of data is initiated by a request from the user.

Spaur also teaches that peripheral devices, such as a PCMCIA unit, can be connected directly to controller 30. These peripherals are electrically connected to the device driver assembly 128 providing communication capability directly between the controller 30 and another

device or unit in the vehicle (see col. 11, lines 15-26). When the user inserts the PCMCIA card to collect data, the request for data is not wirelessly transmitted. Therefore, Spaur also teaches, that the user can request data by physically connecting a PCMCIA device to the vehicle.

However, Spaur fails to disclose, teach or suggest wirelessly receiving “a user specified first schedule for automatically, repeatedly collecting said operational characteristics.” Furthermore, Spaur fails to disclose, teach or suggest wirelessly receiving “a user specified second schedule for automatically, repeatedly and wirelessly transmitting said operational characteristics.”

Claim 1, as amended, recites the following language, among other elements:

    said wireless communication component configured to wirelessly receive a software component identifying a subset of the set of operational characteristics that are monitored by the on-board diagnostic computer, a user specified first schedule for automatically, repeatedly collecting said operational characteristics, and a user specified second schedule for automatically, repeatedly and wirelessly transmitting said operational characteristics,

    said data-collection component configured to process the received software component and to automatically, repeatedly collect from the vehicle’s on-board diagnostic computer data for the subset of operational characteristics identified in the received software component according to said user specified first schedule,

    said wireless communication component being further configured to automatically, repeatedly, and wirelessly transmit said collected data according to said user specified second schedule,

The Office Action asserts that Spaur anticipates the claimed “a user specified rate (i.e. frequency) for automatically querying a vehicle’s on-board computer.” (Office Action, page 34,

paragraph 6). Applicant respectfully submits that claim 1 is patentably distinct from Spaur for at least the reason that Spaur fails to disclose, teach or suggest: 1) wirelessly receiving “a user specified first schedule for automatically, repeatedly collecting said operational characteristics, and a user specified second schedule for transmitting said operational characteristics;” 2) “automatically, repeatedly collect from the vehicle’s on-board diagnostic computer data for the subset of operational characteristics identified in the received software component according to said user specified first schedule;” or 3) “automatically, repeatedly, and wirelessly transmit said collected data according to said user specified second schedule,” as recited in claim 1. Accordingly, withdrawal of the anticipation rejection with respect to claim 1 is respectfully requested.

Applicant further submits that independent claims 2, 15, 32, 33, 37, 38, 51, 52, 69, 73, 77, 82, 85, 87 and 89 are analogous to claim 1 and are likewise allowable for at least the foregoing reasons. Accordingly, withdrawal of the anticipation rejection with respect to claims 2, 15, 32, 33, 37, 38, 51, 52, 69, 73, 77, 82, 85, 87 and 89 is respectfully requested for at least the reason that Spaur does not disclose, teach or suggest all of the elements of these claims.

Applicant further submits that if all of the elements of an independent claim are not present, then all of the elements of any claim depending therefrom are not present. Claims 3-4 and 7-10 depend from claim 2. Claims 17-31 depend from claim 15. Claims 34-36 depend from claim 33. Claims 39-40 and 43-46 depend from claim 38. Claims 54-68 depend from claim 52. Claims 70-72 depend from claim 69. Claims 74-76 depend from claim 73. Claims 79-81 depend

from claim 77. Claims 83-84 depend from claim 82. Claim 86 depends from claim 85. Claim 88 depends from claim 87. Claim 90 depends from claim 89. Applicant respectfully submits that, for at least the foregoing reasons, that claims 3-4, 7-10, 17-31, 34-36, 39-40, 43-46, 54-68, 70-72, 74-76, 79-81, 83-84, 86, 88 and 90 are also allowable.

Applicant does not otherwise concede, however, the correctness of the Office Action rejections with respect to any of the dependent claims discussed above. Accordingly, Applicant hereby reserves the right to make additional arguments as may be necessary to further distinguish the dependent claims from Spaur based on additional features contained in the dependent claims that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

In view of the above, reconsideration and withdrawal of the rejection of claims 1-4, 7-10, 15, 17-40, 43-46, 51-52, 54-77 and 79-90 are respectfully requested.

**SUMMARY**

Applicant submits that the present application is in condition for allowance and requests favorable action in the form of a Notice of Allowance. Should the Examiner believe that this application is in condition for disposition other than allowance, the Examiner is invited to contact the undersigned at the telephone number listed below in order to address the Examiner's concerns.

*By Adam Kaplan  
Reg. No. 435 on behalf  
of Stephen Glazier*

Respectfully submitted,

*Stephen C. Glazier*  
Stephen C. Glazier  
Reg. No. 31,361  
(202) 778-9045

Date: 1/23/07

Kirkpatrick & Lockhart Preston Gates Ellis LLP  
1601 K St., NW  
Washington, DC 20006  
(202) 778-9000  
Fax: (202) 778-9100